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OFFICE OF PETITIONS

In re Patent No. 7,135,607 : DECISION ON REQUEST
Nakamura et al. : FOR
Issue Date: November 14, 2006: RECONSIDERATION OF
Application No. 10/009,950 : PATENT TERM ADJUSTMENT
Filed: December 14, 2001 : and
Atty Docket No. 31671-176197 : NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the "REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(b)," filed October 13, 2006. Applicants request that the determination of patent term adjustment be corrected from zero (0) days to seven hundred twenty-seven (727) days.

The application for patent term adjustment is GRANTED to the extent indicated herein.

Prior to this decision being issued, on November 14, 2006, the application matured into U.S. Patent No. 7,135,607, with a revised patent term adjustment of 364 days. Accordingly, the patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of six hundred fifty-seven (657) days.

On July 14, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days. The instant application for patent term adjustment was timely filed prior to (at the same time as)

the payment of the Issue Fee¹. Applicants request reconsideration of the patent term adjustment on the basis that the Office misplaced the response to restriction filed on April 10, 2003, and on the basis of the Office having failed to issue the patent within three years. Accordingly, applicants assert that the reduction of 293 days associated with the resubmission of the misplaced April 10, 2003 on March 30, 2004 is unwarranted. In support thereof, applicants submitted a copy of the response as filed on April 10, 2003. Further, because the response was actually filed on April 10, 2003, applicants contend that a period of adjustment of 305 days for Office delay in not acting in response until May 18, 2004 should be entered.

Applicants state that this application is not subject to any terminal disclaimers.

Applicants are correct that periods of reduction and/or adjustment should be associated with the filing of their response on April 10, 2003, not March 30, 2004. A review of the record confirms that the submission on March 30, 2004 was a resubmission of the April 10, 2003 with an adequate showing of timely original receipt in the Office on April 10, 2003 (i.e., an itemized and date-stamped receipt). This was within three months of the mailing of the restriction requirement. Thus, the period of reduction of 282 days, pursuant to 37 CFR 1.704(b), is unwarranted and is being removed.

Likewise, entry of a period of adjustment, pursuant to 37 CFR 1.702(a)(2), for the Office taking in excess of four months to respond to receipt of the election on April 10, 2003 is warranted. However, the period of adjustment is 282 days (not 305 days) counting the number of days in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed, August 11, 2003 and ending on the date of mailing of an action under 35 U.S.C. 132, May 18, 2004.

However, given the correction, the entry of a period of adjustment of 675 days for the Office taking in excess of three years to issue the patent is incorrect. It is noted that the instant patent issued 3 years and 700 days after its filing date. However, any days of delay for Office issuance of the patent more than 3 years after the filing date of the

¹ PALM records indicate that the Issue Fee payment was also received on October 13, 2006.

application, which overlap, with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. Further, in considering the overlap, the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). See 35 U.S.C. 154(b)(1)(B); 35 U.S.C. 154(b)(2)(A); and 37 CFR 1.703(f). Previously, only 25 days had been entered for Office delay prior to issuance of the patent. Accordingly, upon issuance of the patent, an additional 675 days was entered for the non-overlapping days attributable to the delay in issuance of the patent. With the corrections, the period of delay of 700 days attributable to the delay in the issuance of the patent overlaps with the adjustment of 307 days attributable to grounds specified in § 1.702(a)(1) and (2). Thus, only an additional period of adjustment of 393 days, not 675 days is warranted.

In view thereof, the patent should have issued with a revised patent term adjustment of six hundred fifty-seven (657) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by six hundred fifty-seven (657) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,135,607 B1
DATED : November 14, 2006
INVENTOR(S) : Nakamura et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (364) days

Delete the phrase "by 364" and insert – by 657 days--